

slots extending from the outer periphery of the respective discs and narrowing toward the center of the respective discs.--

REMARKS

Claims 6-8, 15 and 16 have herein been canceled. Pending claims 13-14 were withdrawn from consideration. New independent claim 17 has been added and is the only claim presented for examination.

Claim 17 is based on claims 6 and 7, now canceled, and is similar to the combination of those claims.

The numbered paragraphs below correspond to those of the Office Action of 12/10/98.

2. Claims 6-8, 15 and 16 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. Specifically, claim 6, line 13, included the term "said rotating axis" which was alleged to lack positive antecedent basis.

Claim 6 has been cancelled and pending independent claim 17 overcomes this alleged defect.

3.-4. Claims 6, 8 and 15 were rejected under 35 U.S.C. 102(b) as being anticipated by Shearer (U.S. 1,471,422).

Those claims have been cancelled. Present claim 17 clearly distinguishes over Shearer, which discloses forceps. For example, claim 17 calls for upper and lower discs, each of which has opposing cutting edges in the form of a slot of fixed dimension. The tool of claim 17 is clearly neither disclosed nor suggested by Shearer. This rejection is therefore overcome.

5. Claims 6-8, 15 and 16, were rejected under 35 U.S.C. 102(b) as being anticipated by British Pat. 20,244 (GB '244).

Again, pending claim 17 clearly distinguishes over GB '244. For example, as was noted above, claim 17 calls for upper and lower discs, each of which has opposing cutting edges in the form of a slot of fixed dimension.

In the Action, the Examiner has referred to GB '244 as having a "disc (e.g., E,K, I) having a slot (e.g., formed by K and I)." Applicant disagrees that the identified elements of GB '244 (or any others) form a "disc." The Figures illustrate a bolt clipper, or the like, comprising jaws I and K which can be brought together or moved apart by rotating jaw carrier E. Even should this be deemed a "disc" such as the disc called for by applicant's claim 17, the cutting edges are not in the form of a slot of fixed dimension, as also called for by claim 17. Furthermore, claim 17 calls for "upper and lower discs," while GB '244 illustrates at most only a single "disc." The tool of claim 17 is clearly neither disclosed nor suggested by GB '244. This rejection is therefore overcome.

6.-7. Claim 6 was rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stolpe (U.S. 690,083).

Claim 6 has been cancelled. Again, claim 17 clearly distinguishes over Stolpe. Claim 17 calls for upper and lower discs, for example, each of which has opposing cutting edges in the form of a slot of fixed dimension. The tool of claim 17 is

clearly neither disclosed nor suggested by Stolpe. Nor is it rendered obvious by Stolpe. This rejection is therefore overcome.

8. Claim 7 was rejected under 35 U.S.C. 103 as being unpatentable over Stolpe in view of Schweitzer (U.S. 4,887,447).

The rejection reads:

"Stolpe discloses a cutting apparatus (e.g. in Figure 2) which discloses or suggests almost every structural limitation of the claimed invention including a handle (e',f') attached respectively to each shearing element but lacks each shearing element comprising a disc having a slot with a cutting edge extending from the outer periphery toward the center. Schweitzer discloses a cutting apparatus wherein the shearing elements each include a disc having a slot with a cutting edge as claimed wherein the slot narrows towards the center, and teaches that peripheral slots are provided for inserting lengths of rebar therein for cutting the rebar. Therefore, it would have been obvious to one having ordinary skill in the art to provide the discs of Schweitzer with slots therein on the cutting apparatus of Stolpe to gain the benefits taught by Schweitzer including that described above."

Again, we traverse.

First, the words "A hand-held tool" in line 1 of claim 17 constitute a limitation distinguishing the cited prior art and that limitation is "structural." Whether a preamble stating the purpose and context of the invention constitutes a limitation of the claimed process is determined on the facts of each case in light of the overall form of the claim, and the invention as described in the specification and illuminated in the prosecution history. See *Applied Materials Inc. v. Advanced Semiconductor Materials*, 98 F.3d 1563, 1573, 40 U.S.P.Q.2d 1481, 1488 (Fed.

Cir. 1996). Applicant's position is not affected by the fact that the present claims are directed to a device instead of a process. The claim must be viewed as a whole.

Second, claim 17 calls for "handles" for rotating the discs to which the handles are attached.

We recognize that the office action in paragraph 8 has taken the position that the elements identified by the characters (e',f') of Stolpe are "handles." Applicants respectfully disagree. Stolpe describes e' and f' as "arms." (Page 2, line 10, referring to Fig. 6) Neither the figures nor the descriptions of those elements disclose what one skilled in the art would understand to be "handles." For example, the relevant definition of the noun "handle" in Webster's Ninth New Collegiate Dictionary, p. 550 (1983) is

1: a part that is designed esp. to be grasped by the hand...

Moreover, Stolpe's "handles" are not used for rotating "discs." Nor is it seen how the "discs" which the Examiner has referred to as being shown in Schweitzer would or could be used in Stolpe's device. It is urged that the substitution suggested by the Examiner could not be made without a new invention being made. Accordingly, claim 17 would not have been obvious at the time the invention was made over the Stolpe, Schweitzer combination alone or whether or not GB '244 and/or Shearer were also applied.

Conclusion

Claim 17 is allowable over the references taken either alone or in combination and a Notice of Allowance should be issued.

A Notice of Appeal is being filed concurrently herewith.

Respectfully submitted,

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